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EXAMINER

BELIVEAU, SCOTT E

ART UNIT PAPER NUMBER

2614

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/692,995

Applicant(s)

JERDING ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 76-115 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 76-79 and 81-115 is/are rejected.
- 7) ☒ Claim(s) 80 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. With respect to applicant's claim for priority to US Pat. Application No. 09/590,488, the subject matter that is common between the two application appears to be related to the overall system architecture and ordering process as illustrated in Figures 1-6. Figure 19C of the earlier '488 application, appears to correspond to Figure 7 of the instant application. However, the earlier filed application does not appear to disclose or illustrate the particular usage of the "bookmark" process as claimed. Accordingly, the claimed subject matter shall not receive the priority of an earlier filing with respect to the '488 application.
2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

In consideration of applicant's claim for priority with respect to provisional application 60/170,302, the provisional application generally introduces the concept of a bookmark in conjunction with the "current rental screen" (Page 13). With respect to claims 76-101 and 115, the provisional application does not provide support the limitations as particularly claimed. Based on the "first user input" (ex. STOP button on the remote control), the

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embodiment displays the current rental screen. Subsequently, "information related to said visual scene" is not stored "responsive to receiving the first user input", but is rather stored responsive to another input associated with the 'B' or "Set bookmark" button. Furthermore, there is no reference as to where the information is particularly stored as claimed.

The provisional application does not disclose or suggest that the user is operable to establish the particular name associated with the bookmark. Accordingly, the provisional application fails to disclose or suggest the limitation of claims 102-109 for "providing a plurality of names corresponding to the plurality of images, wherein each of the plurality of names was selected by a respective user input received by the STT". Similarly, claims 110-111 are not supported, as the provisional application does not particularly disclose the limitation for "associating by the STT a plurality of respective names". Accordingly, for the purposes of evaluation of prior art with respect to applicant's claim to priority to provisional application 60/170,302, the application filing date shall be the filing date of the instant application or 20 October 2000 with respect to claims 76-111 and 115.

Claims 112-114 shall be evaluated based on the earlier filling date of the priority document or 13 December 1999 as the particular association of names may be broadly interpreted as being sequentially generated as illustrated in the aforementioned "current rental screen" (Page 13).

Drawings

3. The drawings were received on 9 March 2003. These drawings are approved.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Newly presented claims 84, 103, 107, and 113, recite the term “normal playback mode”. This term does not appear to be utilized in conjunction with the specification with respect to the bookmarking embodiments.

Claim Objections

5. Claim 111 is objected to because the recitation of “the second image” lacks antecedent basis. For the purpose of examination, it shall be presumed to be the image associated with the “second television signal. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the

time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 76-79, 81-101, and 110-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. (US Pat No. 5,861,906) in view of Wang (US Pat No. 6,501,902).

In consideration of claims 76 and 96, the Dunn et al. reference discloses a “television set-top terminal (STT)” [26/50] coupled via a “bi-directional communication network” [32] to a “server” [40]. As illustrated in conjunction with Figure 2, the “set-top terminal” [50] comprises a “tuner configured to receive a video presentation” [58], “memory” [56], and a “processor” [52] to enable the operation of the terminal (Col 5, Line 59 – Col 6, Line 20) and to facilitate the control and ordering of a video presentation “outputted by the STT . . . as a television signal” [28]. In conjunction with the display of the video presentation, the embodiment discloses that it is contemplated that the viewer would be able to rewind, fast forward, pause, stop, or play the video data stream at their pace, just like the viewer operates a multimedia player such as a VCR (Col 11, Lines 59-67). The reference, however, does not disclose or suggest that the viewer may perform bookmarking operations as is known in conjunction with the operation multimedia player.

The Wang reference discloses a method and apparatus wherein during the “outputting . . . at least a portion of the video presentation as a television signal”, the embodiment “receives a first user input associated with a visual scene contained in the video presentation” and subsequently “stores information related to said scene in the memory of the STT responsive to receiving the first user input” (Col 1, Lines 14-33; Col 1, Line 67 – Col 2, Lines 3; Col 4,

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Lines 1-9). Subsequently, the embodiment “outputs . . . at least another portion of the video presentation as a television signal after information has been stored” in conjunction with the resumption of a play mode. At a later point in time, the embodiment is operable to “receive a second user input configured to request said visual scene in said video presentation after the STT has output the at least another portion of the video presentation” and to “output . . . a television signal of said video presentation starting from a location corresponding to said visual scene responsive to the second user input, where the location corresponding to the visual scene is identified by the STT using the information related to said visual scene” in conjunction with the operation of requesting the particular re-play of the video presentation from the bookmarked point (Col 1, Lines 34-43; Col 2, Lines 3-11; Col 4, Lines 10-45). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Dunn et al. playback controls so as to utilize additional features traditionally associated with multimedia playback devices as explicitly taught by Wang for the purpose of providing a means for selecting a bookmark spot or particular location within a video presentation in an easier and simpler manner (Wang: Col 1, Lines 57-60).

In consideration of claim 77, the Wang reference discloses that embodiment is operable to “store information related to said visual scene in a memory of the STT” so as to particularly identify the particular bit stream corresponding to the bookmark spots, however, it is unclear if such information further “includes storing information identifying a location of said visual scene in relation to a point in said video presentation other than a point corresponding to a beginning of an entirety of the video presentation”. Rather, the reference

would appear to suggest that the particular information comprises storing time information in relation to a point corresponding to the beginning of the presentation (Figure 1). It would have been an obvious matter of design choice to “include storing information identifying a location of said visual scene in relation to a point in said video presentation other than a point corresponding to a beginning of an entirety of the video presentation”, since application has not disclosed that the particular usage of identifying a location of a scene in relationship to a point in said video presentation other than a point corresponding to a beginning of an entirety of the video presentation solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well using a reference point corresponding to the beginning, middle, or end of the presentation for the purpose of providing a means to identify where within a presentation a particular bookmarked scene may be located. For example, presuming that a presentation was 1 hour long and a user bookmarked a location at a point in time 10 minutes into the presentation. One of ordinary skill in the art would recognize that such bookmark might be equivalently located 10 minutes from the start of the program or 50 from the end of the presentation or 20 minutes from the middle of the presentation.

Claim 78 is rejected wherein the “video presentation is a video-on demand presentation” and wherein the “server” [40] is operable to “transmit the portion of said video presentation starting from said visual scene responsive to the second user input” (Dunn et al.: Col 4, Lines 42-49; Col 11, Lines 54-67).

In consideration of claim 79, the combined Dunn et al. and Wang reference do not explicitly disclose nor preclude that the user may further assign a “character sequence” to the

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aforementioned bookmarked scenes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a means whereby the user could further provide a name for the bookmarked visual scene of Wang since it was known in the art to provide user's with the means to add captioning information to thumbnail images and/or to provide customized names for bookmarked locations. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention so as to modify the combined Dunn et al. and Wang references so as to "receive a user input . . .", "store data corresponding to said character sequence" and to further "provide said character sequence simultaneously with an image corresponding to said visual scene responsive to subsequent user input" for the purpose of advantageously providing the user with the means to add further descriptive material describing the particular video object associated with the bookmarked position in order to serve as a further reminder as to facilitate the identification of a location of interest.

In consideration of claim 81, the aforementioned combined references do not explicitly disclose nor preclude the time in which the "character sequence" is assigned. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to assign the character sequence "during a time period when the video presentation is not being provided by the STT" such as being associated in a PAUSE/STOP state for the purpose ensuring that the user does not miss a portion of the presentation while entering a bookmark name.

In consideration of claim 82, the Dunn et al. system discloses that the embodiment is operable to service over 250,000 or more homes (Col 4, Lines 7-17) wherein each user is

operable to control the playback of their own presentation (Col 11, Lines 59-63).

Accordingly, it would have been obvious in light of the combined references such that the embodiment “further comprises receiving a plurality of user inputs configured to assign a plurality of respective character sequences corresponding to a plurality of visual scenes that were bookmarked responsive to a plurality of respective user inputs” for the purpose of advantageously enabling each of the users to select and control their own individual bookmark lists and subsequent playback at their own pace. Furthermore, such sequences would be implicitly “received after the video presentation has been provided to the user” given that the video presentation must have started such that a user can bookmark a scene.

Claim 83 is rejected wherein the embodiment is operable to “receive a user input configured to request information related to said visual scene in said video presentation” such that the “information related to said visual scene” may be broadly construed as “information” or subsequent video images from the video presentation related to the in terms of sequence of presentation from the bookmarked point. Accordingly, the “requested information” is “provided . . . responsive to receiving the user input configured to request information” in conjunction with the playback from the particular scene.

Claim 84 is rejected wherein the “first user input associated with the visual scene is received while the video presentation is being output by the STT in a normal playback mode, wherein outputting the video presentation by the STT is not interrupted responsive to the first user input” (Wang: Col 1, Lines 25-33).

Claim 85 is rejected wherein as illustrated in Figure 3 of Wang, the embodiment further comprises “outputting information confirming that the visual scene has been bookmarked,

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wherein the information overlays a minority portion of a television screen being used to display the video presentation". In particular, as illustrated the "information" comprises 1/4th of the screen.

Claim 86 is reference wherein the "information confirming that the visual scene has been bookmarked" includes an "icon" representative of the bookmarked scene as illustrated in Figure 3 of Wang.

In consideration of claim 87, the combined references suggest that the "information related to said visual scene" is stored in memory of the "STT" [26] "responsive to receiving the first user input". Accordingly, the combined references do not explicitly disclose nor preclude that information may not be further "stored . . . in a memory of the server". It would have been obvious to one having ordinary skill in the art at the time the invention was made to further "store . . . in the memory of the server" for the purpose of advantageously reducing the memory requirements of the local receiver and associated expenses with the STT.

In consideration of claim 88, the Dunn et al. reference discloses that the embodiment is operable to "interrupt [the video presentation] responsive to user input" (Col 11, Lines 59-67). Accordingly, it would have been implicit to the operation of the combined references that a user may "interrupt" the presentation (ex. pause/stop), subsequently restart the presentation some point prior to the "first user input" thereby establishing a bookmark.

Claim 89 is rejected wherein "said second user input corresponds to a thumbnail image corresponding to said visual scene" as illustrated in conjunction with Figure 3 of Wang.

Claims 90 and 97 are rejected wherein “said visual scene is associated with a bookmark list associated with a plurality of visual scenes associated with a plurality of respective user inputs” (Wang: Col 4, Lines 46-66).

In consideration of claims 91 and 98, the Dunn et al. system discloses that the embodiment is operable to service over 250,000 or more homes (Col 4, Lines 7-17) wherein each user is operable to control the playback of their own presentation (Col 11, Lines 59-63). Accordingly, it would have been obvious in light of the combined references such that the embodiment “further comprises associating a plurality of visual scenes with a plurality of respective bookmark lists associated with a plurality of respective users responsive to a plurality of respective user inputs” for the purpose of advantageously enabling each of the users to select and control their own individual bookmark lists and subsequent playback at their own pace.

In consideration of claims 92 and 99, the Dunn et al. system discloses that the embodiment is operable to support a “plurality of respective video presentations” (Col 4, Lines 42-49). Accordingly, it would have been obvious in light of the combined references such that the embodiment “further comprises associating a plurality of visual scenes with a plurality of respective bookmark lists associated with a plurality of respective video presentations responsive to a plurality of respective user inputs” for the purpose of advantageously allowing users who are watching different presentations to bookmark respective scenes for playback.

In consideration of claims 93 and 100, the Dunn et al. reference discloses the particular usage of an expiration period in conjunction with the rental of a video period” (Col 11, Lines

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37-53). The reference, however, does not explicitly disclose nor preclude further “prompting said user to provide input indicating whether said information is to be deleted from the memory of the STT”. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such functionality in conjunction with the combined teachings for the purpose of providing the user with a friendly reminder that the bookmark is to be deleted in conjunction with the expiration of the rental and to subsequently provide the user with the opportunity to save it in conjunction with a renewal/extension of the rental period. Such a method may advantageously provide additional revenue to the provider. For example, by continuing to associate a particular scene with the bookmark list, the provider could subsequently provide the user with the opportunity continue/finish watching the video from a particular point in conjunction with an added fee associated with the renewal/extension of the rental period.

Claims 94 and 101 are rejected wherein the Wang reference discloses “storing an image corresponding to said visual scene in a memory . . . responsive to receiving the first user input” (Col 3, Lines 31-41).

Claim 95 is rejected wherein “said second user input requesting said visual scene corresponding to a thumbnail image corresponding to the visual scene, said thumbnail image being simultaneously provided with a plurality of thumbnail images corresponding to a plurality of visual scenes in the video presentation” as illustrated in conjunction with Figure 3 of Wang.

With respect to claim 110, as aforementioned, the Dunn et al. reference discloses a method whereby a “television set-top terminal (STT)” [26/50] coupled via a “bi-directional

communication network” [32] to a “server” [40] “receives” and “outputs” [28] a “video presentation” a plurality of video presentations for output “outputted by the STT . . . as a television signal” [28]. The reference, as aforementioned, does not particularly disclose nor preclude the particular usage of bookmarking in conjunction with the playback of the selected media during the rental period in conjunction with playback controls traditionally associated with a multimedia player.

The Wang reference discloses a method for “identifying by the STT a plurality of locations in a video presentation responsive to a plurality of respective user inputs” which are “associated by the STT a plurality of respective names” such that the “plurality of respective names includes a first name and a second name . . . [associated with] a first location and a second location” as illustrated in conjunction with Figure 3. The embodiment subsequently “outputs” a “first television signal” associated with a first page of sub-pictures and “configured to encode the first name and an image corresponding to the first location”. Subsequent to “user input received while the first television signal was being output” such as a Page-Up/Down command, a “second television signal” or second page of sub-pictures “being configured to encode the second name and an image corresponding to the second location is generated (Figure 5; Col 1, Lines 15-33; Col 1, Line 67 – Col 2, Line 11; Col 2, Lines 22-42; Col 4, Lines 28-64). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Dunn et al. playback controls so as to utilize additional features traditionally associated with multimedia playback devices as explicitly taught by Wang for the purpose of providing a means for

selecting a bookmark spot or particular location within a video presentation in an easier and simpler manner (Wang: Col 1, Lines 57-60).

Claim 111 is rejected wherein responsive to “receiving a user input corresponding to the second image” the embodiment “provides a portion of the video presentation starting from a location corresponding to the second image” (Wang: Col 4, Lines 46-59).

In consideration of claim 112, as aforementioned, the Dunn et al. reference discloses a method whereby a “television set-top terminal (STT)” [26/50] coupled via a “bi-directional communication network” [32] to a “server” [40] is operable to “receive” a “video presentation” whereby the user is operable to control the presentation of the data stream at their own pace in a manner similar to that of traditional multimedia player . The reference, as aforementioned, does not particularly disclose nor preclude the particular usage of bookmarking in conjunction with the playback of the selected media during the rental period in conjunction with playback controls traditionally associated with a multimedia player.

The Wang reference discloses a method for “identifying a plurality of locations in a video presentation responsive to a plurality of respective user inputs” which are “associated with a plurality of respective names responsive to a plurality of respective user inputs” in conjunction with the bookmarking process. As illustrated in Figure 3, the embodiment “provides a list that includes the plurality of names”. Accordingly, the embodiment is operable to “receive user input corresponding to one of the plurality of names included in the list” whereupon the embodiment “provides a portion of the video presentation starting from a location corresponding to said one of the plurality of names” (Col 1, Line 67 – Col 2, Line 11; Col 2, Lines 22-42; Col 4, Lines 28-64). Accordingly, it would have been obvious to one

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having ordinary skill in the art at the time the invention was made to modify the Dunn et al. playback controls so as to utilize additional features traditionally associated with multimedia playback devices as explicitly taught by Wang for the purpose of providing a means for selecting a bookmark spot or particular location within a video presentation in an easier and simpler manner (Wang: Col 1, Lines 57-60).

Claim 113 is rejected wherein the “first user input associated with the visual scene is received while the video presentation is being output by the STT in a normal playback mode, wherein outputting the video presentation by the STT is not interrupted responsive to the first user input” (Wang: Col 1, Lines 25-33).

Claim 114 is rejected wherein “at least one of the plurality of names was selected by a respective user input from a list of names provided by the STT wherein the “list of names” comprising a list of sequential numbers is selected in response to the “respective user input” associated with the bookmarking of the particular scene.

In consideration of claim 115, the Dunn et al. reference discloses a “television set-top terminal (STT)” [26/50] coupled via a “bi-directional communication network” [32] to a “server” [40]. As illustrated in conjunction with Figure 2, the “set-top terminal” [50] comprises a “tuner configured to receive a video presentation” [58] wherein the “video presentation is a video-on-demand presentation, “memory” [56], and a “processor” [52] to enable the operation of the terminal (Col 5, Line 59 – Col 6, Line 20) and to facilitate the control and ordering of a video presentation “outputted by the STT . . . as a television signal” [28]. In conjunction with the display of the video presentation, the embodiment discloses that it is contemplated that the viewer would be able to rewind, fast forward, pause, stop, or

play the video data stream at their pace, just like the viewer operates a multimedia player such as a VCR (Col 11, Lines 59-67). The reference, however, does not disclose or suggest that the viewer may perform bookmarking operations as is known in conjunction with the operation multimedia player.

The Wang reference discloses a method and apparatus wherein during the “outputting . . . at least a portion of the video presentation as a television signal”, the embodiment “receives a first user input associated with a visual scene contained in the video presentation” and subsequently “stores information related to said scene in the memory of the STT responsive to receiving the first user input” (Col 1, Lines 14-33; Col 1, Line 67 – Col 2, Lines 3; Col 4, Lines 1-9). Subsequently, the embodiment “outputs . . . at least another portion of the video presentation as a television signal after information has been stored” in conjunction with the resumption of a play mode. At a later point in time, the embodiment is operable to “receive a second user input configured to request said visual scene in said video presentation after the STT has output the at least another portion of the video presentation” and to “output . . . a television signal of said video presentation starting from a location corresponding to said visual scene responsive to the second user input, where the location corresponding to the visual scene is identified by the STT using the information related to said visual scene” in conjunction with the operation of requesting the particular re-play of the video presentation from the bookmarked point (Col 1, Lines 34-43; Col 2, Lines 3-11; Col 4, Lines 10-45). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Dunn et al. playback controls so as to utilize additional features traditionally associated with multimedia playback devices as explicitly taught by

Wang for the purpose of providing a means for selecting a bookmark spot or particular location within a video presentation in an easier and simpler manner (Wang: Col 1, Lines 57-60).

The combined Dunn et al. and Wang reference do not explicitly disclose nor preclude that the user may further assign a “character sequence” to the aforementioned bookmarked scenes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a means whereby the user could further provide a name for the bookmarked visual scene of Wang since it was known in the art to provide user’s with the means to add captioning information to thumbnail images. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention so as to modify the combined Dunn et al. and Wang references so as to “receive a user input . . .”, “store data corresponding to said character sequence” and to further “provide said character sequence simultaneously with an image corresponding to said visual scene responsive to subsequent user input” for the purpose of advantageously providing the user with the means to add further descriptive material describing the particular video object associated with the bookmarked position in order to serve as a further reminder as to facilitate the identification of a location of interest.

As aforementioned, the embodiment is operable to “receive a user input configured to request information related to said visual scene in said video presentation” such that “information related to said visual scene” may be broadly construed as “information” or subsequent video images from the video presentation related to the in terms of sequence of presentation from the bookmarked point. Accordingly, the “requested information” is

“provided . . . responsive to receiving the user input configured to request information” in conjunction with the playback from the particular scene.

As aforementioned, the “first user input associated with the visual scene is received while the video presentation is being output by the STT in a normal playback mode, wherein outputting the video presentation by the STT is not interrupted responsive to the first user input” (Wang: Col 1, Lines 25-33). Accordingly, in light of the combined references, the “server” [40] is operable to “transmit the portion of said video presentation starting from said visual scene responsive to the second user input” (Dunn et al.: Col 4, Lines 42-49; Col 11, Lines 54-67).

As aforementioned, as illustrated in Figure 3 of Wang, the embodiment further comprises “outputting information confirming that the visual scene has been bookmarked, wherein the information overlays a minority portion of a television screen being used to display the video presentation”. In particular, as illustrated the “information” comprises 1/4th of the screen and includes an “icon” representative of the bookmarked scene.

9. Claims 102-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budow et al. (US Pat No. 5,625,864) in view of Swenson et al. (US Pat No. 6,064,380).

In consideration of claims 102 and 106, the Budow et al. reference discloses a method and apparatus comprising a “STT” [15] comprising a “processor” [402] that is operable to “receive” and “provide a plurality of images corresponding to a plurality of locations in a video presentation” as delivered via “server” [12] via a “bi-directional communication network” [14]. The aforementioned, “plurality of images corresponding to a plurality of locations” is met wherein the “plurality of locations is associated with a respective user input

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received by the STT” in order to bookmark a particular location or point within a video presentation and to subsequently replay a “plurality of images” from that point (Col 4, Lines 44-58; Col 12, Lines 29-64). The reference, however, does not explicitly disclose the ability of the user to further “provide a plurality of names corresponding to the plurality of images, wherein each of the plurality of names was selected by a respective user input received by the STT”.

The Swenson et al. reference discloses a method for bookmarking video sequences for later playback comprising “providing a plurality of names corresponding to the plurality of images, wherein each of the plurality of names was selected by a respective user input received by the STT” (Figure 3; Col 5, Lines 24-62). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Budow et al. reference to further provide a method by which the user may name a bookmark associated with a video as taught by Swenson et al. for the purpose of providing a means by which a user may advantageously associate a name or other identification with a particular segment for later retrieval (Swenson et al.: Col 2, Lines 23-41).

Claims 103 and 107 are rejected wherein “at least one of the plurality of locations was identified by a respective user input while the video presentation was being output by the STT in a normal play mode” such that a user while watching or normally playing back the video presentation decided to “identify” or bookmark the presentation at the point in which they no longer desired to watch the presentation.

Claims 104 and 108 are rejected wherein the “at least one of the plurality of locations was identified by a respective user input while the video presentation was not being output by the

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STT” given that the user “identified the location” with a name subsequent to stopping the presentation (Swenson et al.: Col 5, Lines 3-24).

In consideration of claims 105 and 109, the Swenson et al. reference discloses that the user is operable to enter a customized name in conjunction with the bookmarked position. The reference, however, does not explicitly disclose that the aforementioned customized name necessarily is selected from a “list of names corresponding to one of the plurality of images”. However, it would have been obvious to one having ordinary skill in the art at the time the invention such that the user would implicitly select a customized name from a “list of names corresponding to one of the plurality of images” for the purpose of selecting a name that is in some way descriptive or serves as a mnemonic for the purpose of aiding the user in retrieving a particular bookmark. For example, if a user was watching “Die-Hard” and they needed to stop the video presentation in order to attend a meeting during a scene in which Alan Rickman (aka Hans Gruber) finally opens the vault containing the bonds, the user would implicitly choose from “list of names” corresponding to that scene in conjunction with the creation of a custom name. The user might select a name simply corresponding to the movie title, or a name corresponding to the particular scene, or a name corresponding to the particular music being played at that moment, etc. Accordingly, in conjunction with the process of selecting a custom name the user mentally chooses from a list. The claim does not explicitly require that the available options from which the user may select from with respect to a list of names is necessarily associated with a system based pre-generated/selected list of names from which the user’s selects as illustrated in Figure 8 of the specification.

Allowable Subject Matter

10. Claim 80 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In particular, the combination of elements of claims 76 and 79 further including the limitations of claim 80 wherein the assigning of a bookmark name during the playback of the video-on-demand presentation are not taught, disclosed, or fairly suggested by the art of record.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Katsuyama et al. (US Pat No. 5,740,304) reference discloses a method and apparatus for replaying recording medium from any bookmark-set position.
- The Matsuzawa et al. (US Pat No. 6,085,185) reference discloses a retrieval method and system for a multimedia data wherein a user may annotate thumbnail images.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-HELP.

SEB
April 16, 2004


JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600